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No.

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1980

SYLVAN R. SHEMITZ,

Petitioner,

v.

DEERE & COMPANY, INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

Anthony P. DeLio, II
Mark F. Wachter
121 Whitney Avenue
New Haven, CT 06510
(203) 787-7462
Counsel for Petitioner

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

The Petitioner, Sylvan R. Shemitz, respectfully prays that a Writ of Certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Seventh Circuit, entered in this proceeding on May 28, 1980.

QUESTIONS PRESENTED

1. Whether the Courts below erred by applying a standard for granting summary judgment lower than, and in conflict with, that applied by other Courts of Appeals.

2. Whether the Courts below improperly invalidated patent claims under 35 U.S.C. §103 by failure to strictly adhere to the criteria mandated by Graham v. John Derre Co., supra?

3. Whether invalidation of patent claims by summary judgment, as being "obvious" under 35 U.S.C. §103, denied Patentee due process in the first challenge to their validity?

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OPINIONS BELOW

The Opinion of the Court of Appeals, not yet reported, appears in the Appendix hereto. Incorporated in the appendix of the Opinion of the Court of Appeals is the Memorandum of Decision and Judgment rendered by the District Court for the Central District of Illinois.

JURISDICTION

The judgment of the Court of Appeals for the Seventh Circuit was entered on May 28, 1980. This Petition for Certiorari was filed within 90 days of that date. Accordingly, this Court's jurisdiction is invoked under 28 U.S.C. §1254 (1).

CONSTITUTIONAL, STATUTORY AND REGULATORY PROVISIONS

U. S. Constitution, Amendment V

> "No person . . . shall be deprived of life, liberty or property, without due process of law; . . ."

Title 35, United States Code §103:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Federal Rules of Civil Procedure, Rule 56(c):

> ". . . The judgement sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. . ."

STATEMENT OF THE CASE

In 1965, the Petitioner, Sylvan R. Shemitz, invented a unit combining structural and lighting elements which made it possible to arrange and furnish office space in a new way. These "Illuminated Room Divider Partition" units not only improve working conditions for the user, but also provide energy efficiencies and installation flexibility as a result of the unique combination of structural and lighting components.

U. S. Patent No. 3,389,246 was duly issued to the Petitioner on June 18, 1968. Patent Claim 2 sets forth the combination of components which constitutes Petitioner's invention, as follows:

(a) a "divider partition panel" means;

(b) a frame, which

(i) extends and is supported along substantially the entire length of the "divider partition panel",

(ii) overhangs a portion of the "divider partition panel" means,

(iii) is open at the top and bottom, and

(iv) is of a height from the floor which is lower than normal standing eye-height, but higher than normal seated eye-height;

(c) illumination means positioned and supported in the frame; and

(d) either a deflector or reflector supported by the frame.

Claim 3 specifies a range of 4.5 to 5.6 feet for the height of the frame above the floor. See Appendix, pages A11 to A12, for the full text of Claims 2 and 3.

Petitioner's invention enjoyed commercial success, with licenses taken under the Patent and installations made in new, large office buildings.

Units infringing Petitioner's Patent claims 2 and 3 were installed and remain in use at the Moline, Illinois headquarters of Respondent Deere & Co., Inc. As a result, Petitioner brought the instant action in Federal Court in the Central District of Illinois. Jurisdiction was conferred under 28 U.S.C. §1338, in this the first suit brought under the Patent.

Respondent challenged the validity of Patent Claims 2 and 3 under 35 U.S.C. §103 in a counterclaim for declaratory judgment. Jurisdiction was claimed under 28 U.S.C. §1338(a), 2201 and §2202. After taking a discovery deposition of Petitioner Shemitz, Respondent moved for summary judgment under Fed. R. Civ. P. 56(c). It's support for summary judgment of obviousness under §103 included, in addition to abridged deposition responses by Mr. Shemitz, U. S. Patent No. 1,457,061 to Guth and "Carrel Divider" constructions located in the library of Reed College, in Portland, Oregon. None of this prior art was known to either Petitioner or the Patent and Trademark Office at the time Petitioner's Patent was prosecuted and issued.

The abridged deposition responses indicated that some of the components utilized in Shemitz' invention were not themselves novel. However, other portions of Shemitz' deposition, as well as the subsequent Shemitz Affidavit, specified that the invention resided in the unique combination of components.

The Guth patent discloses a specialized type of lighting fixture for mounting on a wall, or counter framework, which permits light to be adjustably directed upward and downward. The affidavit of Petitioner's patent expert concludes that the Guth patent fails to teach, suggest or disclose use of any "up/down" lighting, in the context of Petitioner's claimed invention.

The Reed College "Carrel Divider" constructions were installed more than one year before Petitioner made his invention. However, their existence remained unknown to him until shortly after Respondent filed its motion for summary judgment.

Petitioner opposed summary judgment and filed affidavits placing material facts in the record, which disputed and opposed the position of Respondent on several issues of material fact. Most notably, Petitioner provided factual evidence in the record directed to determination of the scope and content of the prior art at the time of the invention, as well as differences between such prior art and the claims at issue. These factual issues constitute the first

two factual inquiries of the three-pronged test mandated by Graham v. John Deere Co., supra.

In opposing summary judgment, Petitioner in the record specified primary differences between his Patent Claims 2 and 3 and the Reed College constructions, which lack;

(a) a "divider partition panel" means, and

(b) a frame which overhangs a portion of a "divider partition panel" means.

Not only are both features recited in the claimed combination, but they interact most critically to provide a unit capable of commercial utilization by dividing work space into defined, semi-private work areas having visual and acoustical privacy. Petitioner's opposing affidavits also set forth

evidence in support of the essential issue of what constituted the "claimed invention" to be measured against the prior art by the Graham v. Deere standards.

Over Petitioner's objections, summary judgment was granted. The District Court adopted Respondent's characterization of the "claimed subject matter" as essentially pertaining to a combination of components which omitted critical elements recited in the combination set forth in Patent Claims 2 and 3. See Appendix, page A4.

The District Court found that, on the basis on the Shemitz deposition statements, "essential features of the claimed invention" were well known, that the Reed College constructions

demonstrate obviousness, and that the Guth patent showed "up-down lighting as in Shemitz".

The District Court also concluded, over Petitioner's objections and without comment or apparent analysis of the record, that no genuine issue existed as to any material fact. The presumption of validity was found to no longer exist, because of "anticipating prior art" which was not before the Patent Examiner. Judgment was reached without benefit of expert testimony, which was rejected as being unnecessary, despite Petitioner's objections.

The district court ruled that, measured against the criteria set forth in Graham v. John Deere Co.,

supra, the "subject matter of the claims at issue" was obvious, so that summary judgment under 35 USC §103 was appropriate.

The Court of Appeals reviewed the lower court action, under 28 U.S.C. §1291, and held in a per curiam decision that Petitioner had failed to establish a genuine issue of material fact, as is required to defeat a motion for summary judgment. The Court of Appeals adopted the District Court Memorandum of Decision as its own.

REASONS FOR GRANTING THE WRIT

1. THE DECISION BELOW CONFLICTS WITH DECISIONS OF OTHER COURTS OF APPEALS AS TO PROPER APPLICATION OF SUMMARY JUDGMENT AND FAILS TO PROPERLY

APPLY THE CRITERIA OF GRAHAM V. JOHN DEERE CO., 383 U.S. 1, TO INVALIDATE PATENT CLAIMS UNDER 35 U.S.C. §103.

In Sartor v. Arkansas Natural Gas Corp., 321 U.S. 620 (1944), the Court enunciated the principles to be applied in ruling on a motion for summary judgment:

> ". . . Rule 56 authorizes summary judgment only where the moving party is entitled to judgment as a matter of law, where it is quite clear what the truth is, that no genuine issues remain for trial, and that the purpose of the rule is not to cut litigants off from their right of trial by jury if they really have issues to try."

321 U.S. at 627. Also see, Poller v. Columbia Broadcasting System, 368 U.S. 464, 468 (1962).

The District Court is without authority to grant summary judgment where the standards set forth in Rule 56(c) have not clearly been met. A motion for summary judgment must be

denied if a triable issue of material fact exists. Fountain v. Filson, 336 U.S. 681 (1949); Also see, Carter v. Stanton, 405 U.S. 669 (1972).

It is not the function of the Court on a motion for summary judgment to decide disputed issues of fact. Soria v. Oxnard School District Board of Trustees, 488 F.2d 579 (9th Cir. 1973) Cert. denied 416 U.S. 951 (1974); United States v. Bissett-Berman Corp., 481 F.2d 764 (9th Cir. 1973); Vickery v. Fisher Governor Co. 417 F. 2d 466 (9th Cir. 1969).

All that is required for a material fact to be in dispute is that there be sufficient evidence in the record to support the claimed factual dispute so that the parties' differing versions of the truth be resolved

after a trial. First National Bank v. City Services Co., 391 U.S. 253, 289 (1968). Any and all doubts as to the existence of an issue of material fact must be resolved in favor of the Petitioner, who was opposing summary judgment. United States v. Diebold, Inc., 369 U.S. 654 (1962), Adickes v. Kress & Co., 398 U.S. 144, 157 (1969); and J. Moore, Federal Practice, ¶56.15 [3] (2nd ed. 1966).

Summary judgment has been used sparingly in patent cases, with the courts applying a high standard to govern application of summary judgment in such cases. Pfizer, Inc. v. International Rectifier Corp., et al, 538 F.2d 180 (8th Cir. 1976); Tee-Pak, Inc. v. St. Regis Paper Company, 491 F.2d 1193 (6th Cir. 1974); Ag Pro,

Inc. v. Sakraida, 437 F.2d 99 (5th Cir. 1971); and Technitrol, Inc. v. Control Data Corp., 550 F.2d 992 (4th Cir. 1977).

35 U.S.C. §103 received its definitive interpretation in Graham v. John Deere Co., supra, wherein the Court, in calling for "strict observance" of its requirements, laid out the analysis to be followed in cases involving the obviousness standard:

> "While the ultimate question of patent validity is one of law, A & P Tea Co. v. Supermarket Corp. [citation omitted], the §103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under §103, the scope and content of the prior art are to be determined; difference between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in

> the pertinent art resolved. Against this backdrop, the obviousness or nonobviousness of the subject matter is determined."

Here, the District Court exceeded its proper function by resolving the disputed issues as to the first two factual inquiries of the test for obviousness mandated by the Graham v. John Deere Co., supra. It compared differences between 1) the proffered prior art with 2) an over simplified and unsubstantiated characterization of the Petitioner's "claimed subject matter." In doing so it omitted critical elements recited in the Petitioner's claims thus failing to observe the second "factual inquiry" requirement of Graham v. Deere.

Petitioner built a record opposing summary judgment which

creates doubt as to the propriety of the District Court's evaluation of the scope and content of the prior art and its determination of differences between such prior art with the complete combination set forth in Patent Claims 2 and 3. The facts in Petitioner's record concerning these issues require that resolution could only properly take place after trial.

Thus, the legal error of the courts below was two-fold. First, they applied an insufficiently rigorous standard, below and in conflict with that applied by other Courts of Appeals, to resolve genuine issues between the parties' positions of record by summary judgment. Second, they found "obviousness" under 35 U.S.C. §103, without the required

strict adherence to the criteria of Graham v. John Deere Co., supra.

2. PETITIONER HAS BEEN DENIED DUE PROCESS BY SUMMARY INVALIDATION OF PATENT CLAIMS AS BEING OBVIOUS OVER PRIOR ART STRUCTURES AND REFERENCE IN FIRST INSTANCE RAISED BEFORE ANY TRIBUNAL.

The application of summary judgment to invalidate Petitioner's Patent claims on the basis of being "obvious" under 35 U.S.C. §103 presents an important question of constitutionally protected due process, which deserves the Court's review.

If due process can be denied a patentee, as by the courts below, confidence in and the strength of the U.S. patent system will be undermined. Disclosure of innovation, which is the

principle public benefit of the patent system, will be discouraged.

The statutory presumption under 35 U.S.C. §282 that a properly issued U. S. patent is valid should not be dismissed by granting summary judgment in the first judicial test of validity, where the prior art was previously unknown to the Patentee and the Patent and Trademark Office.

Following this Court's decision in Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 U.S. 313 (1971), a judgment of patent validity has in rem consequences. Once patent claims are invalidated, re-examination of the validity issue is effectively precluded in any other court, regardless of any change of ownership of the patent or the parties involved. See

Blumcraft of Pittsburgh v. Kawneer Company, Inc., et al., 482 F.2d 542 (5th Cir. 1973); and Kaiser Industries Corporation et al. v. Jones & Laughlin Steel Corporation, 515 F.2d 964 (3rd Cir. 1975).

The Court of Appeals for the Sixth Circuit in Tee-Pak, Inc. v. St. Regis Paper Co., 491 F.2d at 1196, recognized the severe consequences of in rem invalidity and reiterated this Court's emphasis in Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, supra., of the importance of a patentee having a full and fair opportunity to litigate the validity of his patent.

Here, in the first attack upon the validity of the Petitioner's patent, the Court below precluded a full and fair inquiry of the physical

object constituting the prior art, by deciding the case on summary judgment.

Adjudication in strict accordance with the test mandated by Graham v. John Deere Co., supra, under the circumstances of the case below, requires a trial. It requires the full opportunity to present expert testimony, to present and cross-examine witnesses and to present demonstrative evidence, particularly that concerning the physical object alleged to be prior art.

Constitutional due process requires that a patentee not be deprived of his patent property without a full and fair opportunity to litigate the validity of his patent.

Trial certainly should not be precluded where, as here, the patentee rigorously and genuinely disputed the

position of Respondent concerning factual inquiries of the Graham v. Deere test and documented his position in the record.

A determination of patent validity under 35 U.S.C. §102 based upon "anticipation" is straightforward and perhaps more readily adapted to adjudication by summary judgment. However, the standards required for judging validity under §103, on the basis of "obviousness", involves a highly subjective determination, even with strict adherence to the Graham v. Deere test. The subjective nature of the obviousness determination mandates that a patentee who raises and documents the existence, (or even doubt as to the existence), of genuine issues as to the

factual inquiries of the Graham v. Deere test should not be denied his day in court.

The District Court concluded that the subject matter of the claimed invention was obvious over prior art, under §103. This prior art did not anticipate the claimed invention under §102.

Yet the District Court found that the presumption of validity of Petitoner's patent no longer existed, due to "anticipating prior art". This reasoning is faulty and clear error, because obviousness, under §103, is not the equivalent of anticipating, under §102.

The District Court's misconception and confusion of §102 and §103 resulted, in first the erroneous

elimination of the presumption of validity and, the consequent invalidation of Petitioner's Patent under §103. The adoption of this reasoning by the Court of Appeals, further denied the Petitioner due process by summary invalidation of his issued Patent.

The case below presents conflicting legal concepts. Summary judgment could be utilized in cases lacking any genuine issue of material fact to facilitate the efficient administration of justice. However, the subjective nature of an inquiry into obviousness under §103 of the Patent Act, and this Court's proper insistence upon strict adherence to the standards of Graham v. John Deere Co., supra, should not be compromised.

Otherwise, the patentee will be deprived of his patent property without due process of law.

It is respectfully submitted that this conflict must be resolved by denial of summary judgment. Petitioner must be given the full and fair opportunity at trial to have his patent's validity properly adjudicated by resolution of the factual inquiries mandated by the Graham v. Deere test.

If, such invalidation by summary judgment is permitted, the strength, statutory presumption of validity and resulting value of duly issued U. S. patents will be badly eroded.

CONCLUSION

For the reasons stated and referred to above, it is respectfully requested that the Petition for a Writ of Certiorari be granted in this case.

Respectfully submitted,

Anthony P. DeLio, II
Mark F. Wachter
121 Whitney Avenue
New Haven, CT 06510
(203) 787-7462

Counsel for Petitioner

APPENDIX

In the

United States Court of Appeals

For the Seventh Circuit

No. 79-1792

SYLVAN R. SHEMITZ,

Plaintiff-Appellant,

v.

DEERE & COMPANY, INC.,

Defendant-Appellee.

Appeal from the United States District Court for the Central District of Illinois.
No. 78 C 4032—**Robert D. Morgan**, *Judge.*

ARGUED JANUARY 7, 1980—DECIDED MAY 28, 1980

Before SWYGERT, SPRECHER and BAUER, *Circuit Judges.*

PER CURIAM. This appeal is taken by the plaintiff from an order of the district court concluding the invalidity of the patent allegedly infringed and granting the defendant's motion for summary judgment. Measured against the criteria set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the district court determined that the patent in issue was invalid for obviousness under 35 U.S.C. § 103.

Having examined the record, addressed the briefs, and heard oral argument on behalf of the parties, we agree with the district court that the plaintiff has failed

to establish a genuine issue of material fact as is required to defeat a motion for summary judgment under F. R. Civ. P. 56(c). Accordingly, for the reasons given in Judge Morgan's Memorandum of Decision, which we adopt as our own and append hereto, the summary judgment for the defendant is affirmed.

AFFIRMED.

APPENDIX

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF ILLINOIS

SYLVAN R. SHEMITZ,	)	
	)	
Plaintiff,	)	
v.	)	No. 78-4032
	)	
DEERE & COMPANY, INC.,	)	
	)	
Defendant.	)	

MEMORANDUM OF DECISION AND JUDGMENT

On May 31, 1979, at hearing thereon, the court announced allowance of defendant's motion for summary judgment herein and promised a memorandum of its reasons therefor. This is that memorandum.

The following facts are not disputed. Plaintiff, Sylvan R. Shemitz (hereafter Shemitz), is a citizen of Connecticut, and since 1963 has been in the business of rendering lighting, design, and consultation services. Defendant, Deere & Company, Inc. (hereafter Deere), is a Delaware corporation having its principal place of business in Moline, Illinois. Jurisdiction by the court over both of the named parties and over the subject matter of the patent infringement complaint and counterclaim for declaratory relief is uncontested.

This action was instituted by a complaint filed by Shemitz on July 13, 1978, charging Deere with infringement of his United States Patent No. 3,389,246, granted June 18, 1968, on an application, Serial No. 521,068, filed January 17, 1966. Said patent is hereafter referred to as the Shemitz patent. The basis for the charge of infringement is that Deere purchased certain illuminated wall partition dividers alleged to infringe the Shemitz patent and is using same in its corporate headquarters. Although the said patent contains three claims, the charge of infringement is only to claims 2 and 3 thereof.

Deere answered and counterclaimed, seeking a declaratory judgment that the Shemitz patent is invalid and not infringed by Deere. Shemitz filed his reply to said counterclaim, denying the allegations thereof. Deere contends, *inter alia*, that Shemitz patent claims 2 and 3 are invalid, pursuant to 35 U.S.C. § 103, because the differences between the claimed subject matter and the prior art are such that the subject matter as a whole would have been obvious at the time the alleged invention was made to a person having ordinary skill in the art to which such subject matter pertains. The alleged invention was made in 1965, i.e., it was conceived in April, 1965, and was reduced to practice in September, 1965. The art involved is room and desk top illumination in relation to room dividing.

The claimed subject matter essentially pertains to a room divider partition that divides a room into work areas while at the same time providing direct illumination over a desk or the like positioned adjacent thereto, as well as indirect illumination of the remaining room area by means of a light fixture mounted in a frame overhanging a portion of said partition and of a height lower than normal standing eye height but higher than normal seated eye height of an adult person. A reflector is included in the light fixture to assist in directing the light emanating therefrom.[1]

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[1] Claims 2 and 3 of the Shemitz patent read as follows:

"2 A room divider partition for dividing a room having a floor into work areas, at the same time providing direct illumination over a desk or the like positioned adjacent thereto and simultaneously providing light for indirectly illuminating the remainder of the room, the room divider having a divider partition panel means, a frame extending and supported along substantially the entire length of the divider partition panel means, said frame overhanging a portion of the divider partition panel means, the frame open on the bottom and top thereof, and illuminating means positioned and supported in said frame, a member selected from the class consisting of deflector and reflector means supported by said frame, the height of the frame from the floor on which the partition is positioned such that it is lower than the normal standing eye-height but higher than the normal seated eye-height of an adult person.

(Footnote continued on following page)

The prior art relied upon by Deere to demonstrate obviousness constitutes admissions by Shemitz; a carrel-divider construction publicly used at the Reed College Library, Portland, Oregon, as early as October 10, 1963; and United States Patent No. 1,457,061, granted May 29, 1923, to E. F. Guth.

Shemitz admitted during his examination on deposition by defendant's counsel that he did not consider himself to be the first person to have devised a room divider providing direct illumination overhanging a desk while simultaneously providing light that contributes to the indirect illumination of the remainder of the room; nor does Shemitz consider himself the first person to devise a height for the illuminator in such divider that is lower than the normal standing eye height of an adult person positioned adjacent the divider and higher than the normal seated eye height of an adult person positioned at the desk. If this does not constitute admission that the essential features of the claimed invention were well known in the prior art, the Reed College Library construction appears to this court to demonstrate the obviousness of the claimed invention. It is clear that such construction constitutes a carrel-divider with built-in direct/indirect overhanging fluorescent fixtures open at the top and bottom so as to provide direct local task lighting on the associated desk top area as well as simultaneous indirect general illumination of the remaining room area. Furthermore,

---

[1] *continued*

"3 A room divider partition for dividing a room having a floor into work areas, at the same time providing direct illumination over a desk or the like positioned adjacent thereto and simultaneously providing light for indirectly illuminating the remainder of the room, the room divider having a divider partition panel means, a frame extending and supported along substantially the entire length of the divider partition panel means, said frame overhanging a portion of the divider partition panel means, the frame open on the bottom and top thereof, illuminating means positioned and supported in said frame, and a member selected from the class consisting of a reflector and a baffle supported by said frame, the height of said frame is between about 4.5 feet to 5.6 feet above the floor on which the partition is positioned."

the carrel-dividers are of a height such that they are lower than standing eye height but higher than the seated eye height of an adult person using the desk. The Reed College Library lighted dividers, in use since 1963, were not considered by the Patent Office during the prosecution of the Shemitz patent.

The aforesaid Guth patent No. 1,457,061 discloses a lighting fixture attached to a counter providing general illumination of the room in which it is located, as well as illumination of the counter. As stated in the patent, this is accomplished by up-down lighting as in Shemitz, wherein the upwardly directed lighting affords the general room illumination and the downwardly directed light provides localized illumination of the adjacent counter area. Guth is of further significance in providing that the lighting fixture includes adjustable reflectors on both sides of the light, which is an incidental feature of the Shemitz patent claims in issue. The Guth patent was not cited during the prosecution history of the Shemitz patent application.

Such prior art, individually or in combination, demonstrates that the differences, if any, between the claimed subject matter of Shemitz patent claims 2 and 3 and the prior art are such that the claimed subject matter as a whole was obvious in 1965, at the time the alleged invention was made, to a person having ordinary skill in the art to which said subject matter pertains. Mr. Shemitz, himself, specified that the art to which his claimed subject matter pertains can be described as "illuminated office furniture and partition systems," and also asserted that the level of ordinary skill in the art at the time of his alleged invention was "knowledge of a table or desk lamp and knowledge of wall, valance, or ceiling lighting." This may be slightly restricted, but seems sufficient to render the claimed invention in claims 2 and 3 invalid, as obvious under 35 U.S.C. § 103.

This court therefore concluded that it had jurisdiction over both the named parties and over the subject matter of the complaint and counterclaim. Rule 56(c), F. R. Civ. P., provides in pertinent part that a motion for summary judgment should be rendered "forthwith if the pleadings, depositions, answers to interrogatories, and

admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Rule 56 applies to patent cases and is used where, as here, the structure and mode of operation of the invention described and claimed in the patent may be readily comprehended by the court without need for technical explanation by expert witnesses and in such circumstances; if said invention is found invalid because of the prior art, then summary judgment is proper. *Research Corporation v. Nasco Industries, Inc.*, 501 F.2d 358, 361-362 (7th Cir. 1974), *cert. denied*, 419 U.S. 1096 (1974). Validity of patent claims is not immune from disposition on motion for summary judgment even though, in addition to prior art patents, deposition testimony and affidavits are involved, if no genuine issue of material fact is present. *A R Inc. v. Electro-Voice, Incorporated*, 311 F.2d 508, 511 (7th Cir. 1962).

35 U.S.C. § 282 provides that an issued patent shall be presumed valid. However, where, as here, the anticipating prior art was not before the Patent Examiner, there is no longer such a presumption. *Rockwell v. Midland-Ross Corp.*, 438 F.2d 645, 650 (7th Cir. 1971). 35 U.S.C. § 103 provides that "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Obviousness must be evaluated under the standards adopted by the United States Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), requiring an evaluation of the scope and content of the prior art at the time of the invention, the differences, if any, between the prior art and the claims at issue, and the level of ordinary skill in the art. *Centsable Products, Inc. v. Lemelson*, Civ. No. 78-1969, decided January 23, 1979 (7th Cir.) at 3-4; *Research Corporation v. Nasco Industries, supra* at 361.

Measured against those criteria, the subject matter of the claims at issue was clearly obvious at the time the invention was made, to a person having ordinary skill in the art to which said subject matter pertains, so that summary judgment by reason of the provisions of 35 U.S.C. § 103 is appropriate. *Centsable Products, Inc. v. Lemelson, supra*; *Research Corporation v. Nasco Industries, Inc., supra* at 360-362; *A R Inc. v. Electro-Voice, Inc., supra* at 511-512; *Davison Chemical Corp. v. Joliet Chemicals*, 179 F.2d 793, 794-795 (7th Cir. 1950), *cert. denied*, 340 U.S. 816 (1950); and *Hancock Laboratories, Inc. v. American Hospital Supply Corp.*, 199 USPQ 279, 283-284 (N. D. Ill. 1978).

Invalid patent claims cannot be infringed, and therefore the counterclaim for declaratory judgment, that Shemitz patent claims 2 and 3 are invalid and not infringed, must be granted in all respects, with a recovery of costs against the plaintiff. The law is with the defendant and against plaintiff on the complaint and answer, as well as on the counterclaim and reply to said counterclaim.

Accordingly, IT IS ORDERED that claims 2 and 3 of the Shemitz patent are invalid and not infringed, judgment is entered in favor of defendant and against plaintiff on the complaint, answer and counterclaim, with costs against the plaintiff.

ROBERT D. MORGAN
United States District Judge

Entered: JUNE 6, 1979
Nunc Pro Tunc May 31, 1979

A true Copy:
Teste:

Clerk of the United States Court of Appeals for the Seventh Circuit

USCA 4512—Midwest Law Printing Co., Inc., Chicago—5-28-80—350

Per Curiam Opinion

JUDGMENT - ORAL ARGUMENT

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

Chicago, Illinois 60604

May 28, 1980

Before

Hon. LUTHER M. SWYGERT, Circuit Judge

Hon. ROBERT A. SPRECHER, Circuit Judge

Hon. WILLIAM J. BAUER, Circuit Judge

SYLVAN R. SHEMITZ, Plaintiff-Appellant, No. 79-1792 vs. DEERE & COMPANY, INC., Defendant-Appellee.	Appeal from the United States District Court for the Southern District of Illinois, Rock Island Division No. 78-C-4032 Robert D. Morgan, JUDGE

This cause was heard on the record from the United States District for the Southern District of Illinois, Rock Island Division, and was argued by counsel.

On considered whereof, it is ordered and adjudged by this Court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, AFFIRMED, with costs, in accordance with the opinion of this court filed this date.

U.S. PATENT NO. 3,389,246

Claim 2

"2. A room divider partition for dividing a room having a floor into work areas, at the same time providing direct illumination over a desk or the like positioned adjacent thereto and simultaneously providing light for indirectly illuminating the remainder of the room, the room divider having a divider partition panel means, a frame extending and supported along substantially the entire length of the divider partition panel means, said frame overhanging a portion of the divider partition panel means, the frame open on the bottom and top thereof, and illuminating means positioned and supported in said frame, a member selected from the class consisting of deflector and reflector means supported by said frame, the height of the frame from the floor on which the partition is positioned such that it is lower than the normal standing eye-height but higher than the normal seated eye-height of an adult person."

Claim 3

"3. A room divider partition for dividing a room having a floor into work areas, at the same time providing direct illumination over a desk or the like positioned adjacent

thereto and simultaneously providing light for indirectly illuminating the remainder of the room, the room divider having a divider partition panel means, a frame extending and supported along substantially the entire length of the divider partition panel means, said frame overhanging a portion of the divider partition panel means, the frame open on the bottom and top thereof, illuminating means positioned and supported in said frame, and a member selected from the class consisting of a reflector and a baffle supported by said frame, the height of said frame is between about 4.5 feet to 5.6 feet above the floor on which the partition is positioned."